

## **REMARKS**

### **I. PRELIMINARY REMARKS**

Claims 1, 33 and 34 have been amended. Claims 35-57 have been added. No claims have been canceled. Claims 1-9 and 28-57 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

### **II. PRIOR ART REJECTIONS**

#### **A. The Rejections**

Claims 1-7, 9 and 28-30 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,785,706 to Bednarek (the Bednarek '706 patent). Claims 1-8 and 28-34 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of U.S. Patent No. 5,584,872 to LaFontaine (the LaFontaine '872 patent) and U.S. Patent No. 5,792,140 to Tu (the Tu '140 patent). The rejections under 35 U.S.C. §§ 102 and 103 are respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

#### **B. The Claimed Combinations**

Independent claim 1 calls for a combination of elements comprising "a shaft," "a plurality of energy transmission devices supported on the shaft," "a tissue cooling apparatus supported on the shaft including an outer member positioned about the plurality of energy transmission devices such that a continuous fluid transmission space is defined therebetween having an inlet and an outlet" and "a drainage tube that conveys fluid passing through the fluid transmission space outlet away from the tissue."

Claims 2-9 and 28-34 depend from independent claim 1 and by definition include, *inter alia*, the combination of elements recited in claim 1.

**C. Discussion Concerning the Rejection Under 35 U.S.C. § 102**

The Bednarek '706 patent discloses a catheter and introducer apparatus in which the catheter can move within the introducer after the introducer has been positioned within the patient. There are a variety of differences between the respective combinations defined by claims 1-7, 9 and 28-30 and the apparatus disclosed in the Bednarek '706 patent. For example, the Bednarek '706 patent fails to teach or suggest a combination of elements including "a drainage tube that conveys fluid passing through the fluid transmission space outlet away from the tissue," as recited in independent claim 1. To the contrary, and as illustrated in Figure 8, the Bednarek introducer includes a plurality of ventilation openings 22 "that permit fluids to flow in and out." [Column 9, lines 31-40.]

As the Bednarek '706 patent fails to teach or suggest each and every element of the combination recited in independent claim 1, applicant respectfully submits that claims 1-7, 9 and 28-30 are patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

**D. Discussion Concerning the Rejection Under 35 U.S.C. § 103**

The LaFontaine '872 patent discloses a variety of different RF energy treatment devices. Each of the treatment devices includes a single electrode and a structure, within which the electrode is recessed, for conveying an electrolytic fluid through the electrode ***to the tissue being treated***. Thus, in clear contrast to the invention defined by independent claim 1, the LaFontaine '872 patent fails to teach or suggest a combination of elements including, *inter alia*, "a drainage tube that conveys fluid passing through the fluid transmission space outlet ***away from the tissue***."

The Tu '140 patent fails to remedy the aforementioned deficiencies in the LaFontaine '872 patent. For example, and referring to Figure 3, the Tu patent discloses a catheter 2 including a tip electrode 12 with a plurality of hollow needles 13 and a band electrode 14 with a plurality of hollow needles 15. Each of the needles defines a passage 20 and an outlet port 21, which direct fluid from the interior of the catheter 2 through the electrodes 12 and 14. [Column 7, lines 11-26.] Given that there is nothing around the electrodes 12 and 14, as well as the fact that the passages 20 are perpendicular to the longitudinal axis of the catheter 2, the **fluid will be delivered to the tissue surface** as well as the surface of the electrodes 12 and 14. As such, and even assuming *arguendo* that was some reason to combine the references in the manner proposed in the Office Action, the Tu '140 patent would not have suggested modifications to the devices disclosed in the LaFontaine '872 patent that would have resulted in one of the devices including, *inter alia*, "a drainage tube that conveys fluid passing through the fluid transmission space outlet **away from the tissue.**"

As the LaFontaine '872 and Tu '140 patents fail to teach or suggest the combination of elements recited in independent claim 1, whether viewed alone or in combination, applicant respectfully submits that claims 1-8 and 28-34 are patentable thereover and that the rejection of claims 1-8 and 28-34 under 35 U.S.C. § 103 should be withdrawn.

### III. NEWLY PRESENTED CLAIMS 35-57

Newly presented claims 35 and 36 depend from independent claim 1 and, accordingly, are patentable for at least the same reasons as claim 1.

Newly presented independent claim 37 calls for a combination of elements comprising "a shaft defining a distal end and a proximal end," "a plurality of energy transmission devices supported on the shaft" and "a tissue cooling apparatus supported on the shaft including an outer member, configured to permit ionic transfer while substantially preventing fluid perfusion therethrough, positioned about the plurality of energy transmission devices such that a continuous fluid transmission space is defined

therebetween having an inlet and an outlet." Applicant respectfully submits that the cited references fail to teach or suggest such a combination and that claims 37-48 are patentable thereover.

Newly presented independent claim 49 calls for a combination of elements comprising "a shaft defining an exterior, a distal end and a proximal end," "a plurality of energy transmission devices supported on the shaft" and "a tissue cooling apparatus, fixedly secured around the exterior of the shaft, including an outer member positioned about the plurality of energy transmission devices such that a continuous fluid transmission space having an inlet and an outlet is defined between the tissue cooling apparatus and the exterior of the shaft." Applicant respectfully submits that the cited references fail to teach or suggest such a combination and that claims 49-57 are patentable thereover.

#### **IV. CLOSING REMARKS**

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such

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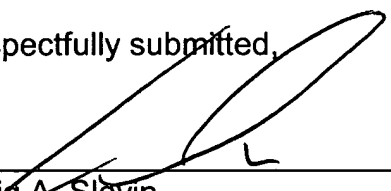
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fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

1/2/07  
Date

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